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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/940,203	09/29/97	POSSIDENTO	W

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IM61/0209

EXAMINER MANOHARAN, V	
ART UNIT 1764	PAPER NUMBER

DATE MAILED: 02/09/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/940,203

Applicant(s)
WILLIAM POSSIDENTO

Examiner
VIRGINIA MANOHARAN

Group Art Unit
1764



☒ Responsive to communication(s) filed on Nov 9, 1998

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 13-22 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 13-22 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Applicant is advised that claims 11-20, submitted with the amendment of 11/9/98, paper #6, have been renumbered as claims 13-22 because of Rule 1.126.

Also, in response to this Office action, applicant is requested to submit Figures 5-7 of the drawings for examiner's review, as they are not of record on file. The drawings are either lost or not submitted with the amendment of Sept. 29, 1997, paper #4.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the following claimed languages such as (a) "said outer tube... having a central plain running parallel having parallel to said central axis so as to bisect said outer tube into an upper section and a lower section", recited e.g. in claims 13 and 18; (b) "being of substantially air tight ^{construction} continuation..." recited in claims 13 and 18; (c) "Said lower section having a parabolic shape" recited e.g. claims 14 and 19; (d). "said trough portion having a mid line bisecting the length of said trough and said midline being oriented at an angle with respect to the horizontal so as to urge the flow of liquid in one direction" recited in claims 13 and 18 are all not positively recited in the specification.

Claims 13-22 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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The following claimed language that are not supported in the specification as filed are as follows: (1) "said outer tube is divided into two halves... each of said halves in connection with a means for hinging said halves so as to allow said halves to pivot with respect to one another.." recited in claims 17 and 22. Compare with the insertion on page 5, line 21 (Preliminary amendment).

The trough and not the outer tube is being referred with respect e.g., to hinging; and the claimed language (2) "said outer tube being of rigid construction.." recited in claims 13 and 18.

The abstract of the disclosure is objected to because of the same reasons as set forth at page 2, first paragraph of the previous Office action.

The disclosure is objected to for the same reasons as set forth at the second full paragraph of the previous Office action.

The drawing is objected to for the same reasons as set forth at the second to the last paragraph of the previous Office action.

Claims 13-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear whether the liquids do in fact flow to the outer tube with the recitation of "adapted for" The term "adapted for" and "adapted to" should be deleted in the claims to obviate this rejection.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hay's publication or Fisher in view of Kruse or Snyder.

The above references are applied for the same combined reasons as set forth at pages 3-4 of the previous Office action.

Applicant's arguments filed November 9, 1998 have been fully considered but they are not persuasive. Applicant's following arguments such as: "The applicant's claimed invention has the cylindrical shape and additionally has a tube or trough inside... Hay's figures 6 and 6a may be thought of as a conical subterranean greenhouse but is not a trough collector or even a flat plate collector" are not considered well-taken. The claims are not limited to the argued "cylindrical shape" or to a "flat plate collector" nor preclude Hay's "conical subterranean green house" commensurate with the argument.

In like manner, the arguments below are not commensurate with the scope of the claims. They either ^{are} not found in the claims or the claims do not preclude them with ^{the} "comprising" recitation. For example only, noting in particular the underlined words.

"...Similar considerations inure to the Kruse ^(sic) and Snyder devices. For example, the Kruse device is designed to float as a boat and hence impose limitations as to size... However, the

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applicant's construction does allow such possibilities. Same is true for Snyder which is also designed as a buoy and suggests a length of 50-100 feet. Again this cannot compare with the applicant's device which permits a pipeline of miles or hundreds of miles in length.

Further, ^{new} applicants' argument that the Hay's reference does not show the idea of a continuous feed of liquid from end of the distillation device which is claimed in the applicant's invention. Note Figure 5 of the applicant's drawings as well as written description teach this idea. The Hay reference does not show or suggest the need for the trough on the inside of the applicant's apparatus to be tilted in one direction in order to facilitate the flow of liquid through the device" are not persuasive of patentability for the following reasons: (a) Applicant cannot read limitations only set forth in the description into the claims for the purpose of avoiding prior ^{art} (b). Contrary to applicants' assertion, The Hay's publication disclosure at page 2, last full paragraph would at least be suggestive of the argued "...trough... to be tilted in one direction in order to facilitate the flow of liquid through the device..." That is Hay discloses that "... a condensate-collecting trough can be suspended from the underside of the V. cover... still should be slightly inclined to facilitate drainage... an underlying sloped collecting trough." (underlying supplied).

Moreover applicants' argument that ["]None of the prior art shows or suggests the idea of photochromic materials in connection with the outer tube of the applicant's apparatus. Such materials may be of great value to the applicant's apparatus in particular as the use of such materials allows the apparatus to be self adjusting in terms of the interior temperature level and such considerations may enhance the distillation process as it occurs over the length of the outer

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tube..." is not considered well-taken. The argued "photochromic materials" is not even recited in the independent claims and therefore is deemed not critical or important to applicants' invention.

Thus, in absence of anything which may be "new" or unexpected result, a prima facie case of obviousness has been established by the art and has not been rebutted.

Unexpected results must be established by factual evidence. Mere arguments or conclusory statements in the specification, appellants' amendments, or the Brief do not suffice. In re Lindner, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972). In re Wood, 582, F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire **THREE MONTHS** from the date of this action. In the event a first response is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period


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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

V. Manoharan/mm

February 4, 1999


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